

SERIAL NO: 09/964,301

Attorney Docket # P04278US5

Remarks**A. Overview**

Claims 1-46 were pending in the present application. Claims 9, 20, 22, 29 and 32-42
5 have been withdrawn from present consideration. This response is an earnest attempt to place
the application in from for allowance. Reconsideration is respectfully requested.

B. Election/Restriction Requirement

Applicant acknowledges the election of the species in Paper 6. However, it is noted
10 that claims 1 and 21, still pending in this application, were found generic by the Examiner.
Therefore, Applicant reserves the right to request re-instatement of the withdrawn claims at
such time a generic claim is found allowable in this application, and therefore does not cancel
the withdrawn claims.

C. Section 102 Rejections

15 Claims 1-6, 8, 10-14, 16-19, 21-28, 30-31, and 43 have been rejected as anticipated by
Okuto .S. Patent 3,865,498. This rejection is respectfully traversed for the following reasons.

1. The Cited References

Cited reference Okuto describes a method of "joining a plurality of steel tubes 1"
20 (Okuto col. 2, line 27) by a specific slip joint between tubes (see Okuto title and specification
generally). Its drawings show a concrete footing (called a "foundation 3" in the ground with
the top of the footing at ground level. The Okuto specification says that the pole is "supported
at its lower end in a foundation 3" (Okuto col. 2, line 37).

SERIAL NO: 09/964,301

Attorney Docket # P04278US5

There is no discussion of exactly how the steel pole 1 is attached to the concrete foundation 3. Undoubtedly, this is because the invention is the slip-joint between steel pole sections (see Okuto claims).

Applicants' invention is an apparatus and method for supporting structures to elevated heights. It addresses both how the apparatus is supported in the ground and how the structures are elevated. Specifically, Applicants' invention is a departure from the state of the art in that it describes a pole that can be slip fit upon a stub that extends from the ground. Applicants' specification goes into detail why this is novel and advantageous over the state of the art (see, e.g., Applicants' specification pages 1-9 and 29).

Okuto discloses no more than the state of the art. Okuto discloses pole sections slip fit together. Applicant is not claiming that broad concept here. Okuto discloses a concrete foundation which supports the steel pole at its lower end. As seen in Okuto, the steel pole extends to ground level and the concrete foundation is not shown above ground level. Okuto shows a flange at the lower end of the steel pole. It is submitted that Okuto suggests only the standard prior art way of attaching steel pole to concrete foundation, a flange at the pole lower end which is bolted to the concrete foundation. The Jatcko cited reference shows this arrangement in more detail, as does Applicant's specification describing the "prior art" shown in Applicants' Figure 3.

In the other hand, the other cited reference, the Centrecon II-50 brochure, shows the state of the art direct burial pole (see also Applicants' "prior art" Figure 2 and corresponding description). The massive pole has a lower end that is buried in the ground. There can be back-filling around the buried end to help support the pole, but it remains that a substantial

SERIAL NO: 09/964,301

Attorney Docket # P04278US5

majority of the Centracon structure is the pole from its buried end to a substantial height in the air. Centracon does slip fit a steel top portion with cross arms and lights to the top of its concrete pole, but this top part is a fraction of the size of the pole.

Applicants' specification describes why these two approaches (the Okuto/Jatcko type
5 bolt-down steel pole and the Centracon and others type direct burial poles) have deficiencies and create problems. For example, just the task of manipulating a large pole into a hole in the ground, and trying to install it plumb, is daunting. It is very difficult to do efficiently. A hundred foot tall pole can require a crane to hold it while the buried end of the pole is shored up. If concrete back fill is used, the crane is out of commission for hours, if not days.

10 The Okuto/Jatcko bolt-down system requires very precise construction of a foundation with bolts that match the hole pattern on the flange of the bottom of the pole. Workers must dangle the large pole over the bolts and then turn multiple nuts down on the bolts. The pole must be plumbed and shims or other means used to keep it plumb. Further, the bolts are usually at or near ground level, making them susceptible to corrosion. This could cause
15 failure of the connection (a safety risk). It also makes it difficult to remove the pole.

These are just some of the problems associated with the cited references. These are very practical problems in the state of the art. These types of poles are frequently used to suspend sports lighting for schools and municipalities. Cost is a critical factor for school districts and cities. Therefore, the expense of cranes or labor can add substantially to sports
20 lighting systems of the type of the cited references.

SERIAL NO: 09/964,301

Attorney Docket # P04278US5

2. Applicants' Claims

In comparison to the cited art, Applicant's independent claims set forth a combination which includes a pole and a base, where in the base is installable into the ground with an upper end which extends above ground. The lower end of the pole slip fits over the upper end of the base. On this basis alone, a substantially tall pole can be picked up, popped onto the exposed stub of the base, and is essentially installed. The smaller base be easily and economically installed in the ground and plumbed ahead of time. Larger machines can then be used to pop the large poles onto the pre-installed, plumb bases. As emphasized in Applicants' specification, the advantage of having an efficient and economical way to plumb the base, is significant. There is no worry about whether the tall top of the pole will be plumb. But further, the quickness of just popping (slip fitting) the pole onto the base is also significant. Still further, the ability to hold the lower end of the pole well above ground level usually eliminates the problem of water affecting the joint between pole and base.

Applicants' original claims are submitted to articulate these meaningful differences from the cited art, including Okuto. However, in an effort to advance prosecution of this application, Applicants' independent claims 1, 21, 43, and 44 have all been amended to more explicitly emphasize these differences. For example, claim 1, as amended, explicitly describes both pole and base having a respective length, and the length of the pole is substantially longer than the base. And further, the lower end of the base is insertable into the ground with its upper end extending above ground, and when the pole is installed on the upper

SERIAL NO: 09/964,301

Attorney Docket # P04278US5

end of the base, the lower end of the pole is held above the ground, but nearer the ground than the top of the pole.

It is therefore respectfully submitted that claim 1 has limitations not disclosed or taught in Okuto. Okuto does not have a base with upper end above ground or a pole that slip
5 fits over the base upper end. Okuto does not have the limitations of Applicants' claim 1 in the arrangement of Applicants' claim 1. Okuto does not, therefore, support a *prima facie* case of anticipation under Section 102 because of the absence of these limitations in Okuto. It is therefore respectfully submitted that claim 1 is allowable over Okuto. Claims 2-6, 8, 10-14, and 16-19 are dependant from claim 1 and submitted to be allowable for the reasons expressed
10 in support of claim 1.

Independent claims 21, 43, and 44 have similar limitations. It is therefore respectfully submitted that the remaining pending claims are allowable over Okuto.

D. Section 103 Rejections

Claims 1-8, 10-19, 21, 23-28, 30-31, and 43-46 have been rejected as obvious because
15 of the teachings of the Centracon Sportsliner II-50 publication of record. Claims 18 and 28 have been rejected as obvious based on the teachings of the Centracon Sportsliner II-50 publication in view of Jatcko U.S. Patent 3,713,262. These rejections are respectfully traversed for at least the following reasons.

The Centracon brochure has been discussed earlier. To support a *prima facie* case of
20 obviousness under Section 103, the cited reference(s) must provide a reason, suggestion, or

SERIAL NO: 09/964,301

Attorney Docket # P04278US5

motivation to combine or modify the references in a manner which appears to show or suggest the claimed invention to one of ordinary skill in art.

Centrecon is a variation of the age-old practice of direct-burying the lower end of tall poles in the ground (e.g. tall, heavy wood or concrete poles). It eschews the more modern
5 practice of bolting down the lower end of the pole at ground level to a pre-installed base in the ground (e.g. with tubular metal poles).

Jatcko is an example of the more modern use of hollow tubular steel poles which are bolted down on concrete footings in the ground. Jatcko eschews the practice of direct-burial of the end of a heavy, tall pole.

10 This is a classical case of both cited references teaching in different directions. Those two paradigms for installing poles in the ground are not reconcilable. Therefore, not only is there no teaching or suggestion of Applicants' claims in either Centracon brochure or Jatcko, but there is no teaching or suggestion or motivation to combine their teachings. They teach in different directions. Again, they are not reconcilable. *See, e.g., In re Fitch* 23 USPQ 1780,
15 1783-84 (Fed Cir. 1992). *See also Ex Parte Levengood* 28 USPQ 1300, 1302 (Fed. Cir. 1993).

Even if the teachings of Centracon and Jatcko were combined, it would not result in the Applicants' claimed invention. It would result in a bolt-down pole with a slip-fit top. It would not result in teaching of a long pole, an in-ground base with exposed stub end, and a
20 connection of pole to base by slip fitting lower end of pole to exposed stub end of base.

It is therefore respectfully submitted that Applicants' claims are not obvious in light of the Centracon brochure or Jatcko, either singly or in combination. These references teach

SERIAL NO: 09/964,301

Attorney Docket # P04278US5

away from Applicant's claims. The only suggestion of Applicants' claimed invention is Applicants' disclosure. As the Board of Patent Appeals and Interferences has stated, "citing references which merely indicate that isolated elements and/or features recited in claims are known is not sufficient bases for concluding that the combination of claimed elements would
5 have been obvious." Ex parte Hiyamizu, 10 USPQ2d 1393, 1394 (BPAI 1988). As stated by the Federal Circuit,

It is wrong to use the patent-in-suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims-in-suit.

10

Orthopedic Equipment Co. v. United States, 702 F.2d 1005, 1012, 217 U.S.P.Q. 193, 199 (Fed. Cir. 1983).

It is therefore respectfully submitted that Applicants' claims are allowable over the Centracon brochure and Jatcko.

15

Additionally, the cited prior art does not disclose a pole held above but generally near the ground, which is an explicit limitation of independent claims 1, 21, 43 and 44. There must be an explicit suggestion in the cited art of the invention as a whole to support a § 103 rejection.

20

D. Conclusion

It is respectfully submitted that each of the matters raised in the last office action in the parent application have been addressed and remedied. The claims, as amended, distinguish from the cited art. Favorable action is respectfully requested.

25

Applicant respectfully requests entry and reconsideration based on this response, and a three-month extension of time. Please charge any required fee for entry of this response,

SERIAL NO: 09/964,301

Attorney Docket # P04278US5

including the extension of time fee, to deposit account #26-0084. It is not believed that any further fee or extension is due with this response. If any fee and/or extension of time has been inadvertently overlooked please consider this a request therefore and charge deposit account #26-0084 for any required fee.

5

Respectfully submitted,

10

Mark D. Hansing Reg. No. 30,643

MCKEE, VOORHEES & SEASE

801 Grand Avenue, Suite 3200

Des Moines, Iowa 50309-2721

15

Phone No. (515) 288-3667

Fax No. (515) 288-1338

CUSTOMER NO: 22885

Attorneys of Record

- mms-

OFFICIAL

FAX RECEIVED

AUG 28 2003

GROUP 3600

09/11/2003 PFARRIER 00000007 260084 09964301

01 FC:1253 930.00 DA